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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,716	11/10/2003	John Allen Robinson	AM100401	5638

26691 7590 06/17/2005

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EXAMINER

DESAI, ANAND U

ART UNIT PAPER NUMBER

1653

DATE MAILED: 06/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/705,716

Applicant(s)

ROBINSON ET AL

Examiner

Anand U. Desai, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-88 is/are pending in the application.
- 4a) Of the above claim(s) 1-7, 13-37 and 43-88 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-12 and 38-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 20050314.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This office action is in response to Amendment filed on April 4, 2005. Claims 1-7, 13-37, and 43-88 have been previously withdrawn. Claims 8-12, and 38-42 are currently under examination.

#### **Withdrawal of Rejections**

2. The rejection of claim 8 under 35 U.S.C. § 101 as being drawn to non-statutory subject matter is withdrawn based on Applicant's amendment to the claim.

3. The rejection of claims 8-12, and 38-42 under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph as being indefinite is withdrawn based on Applicant's amendment to the claims.

4. The rejection of claims 8-12 and 38-42 under 35 U.S.C. § 102(e) as being anticipated by Afar, D. et al. (WO 03/025138 A2; Effective filing date = September 17, 2001) is withdrawn based on Applicant's submission of a declaration under 37 C.F.R. § 1.131.

#### **Maintenance of Rejections**

##### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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6. Claims 8-12, and 38-42 are rejected under 35 U.S.C. 102(e) as being anticipated by Tanner et al. US 2003/0119043 A1 (Effective filing date=November 9, 2001). Tanner et al. disclose a polypeptide sequence that has 100 % identity to the currently claimed polypeptide identified as SEQ ID NO:4 (see US 2003/0119043 A1, pg. 27-28, SEQ ID NO: 17, current application, claims 8-12, 38, and 42). A disclosed structural polypeptide will inherently dictate a function upon the disclosed polypeptide. Therefore, the peptide that has 100 % identity would be expected to possess the function currently being claimed (current application, claims 11, 40, and 41).

#### Response to Remarks

7. The declaration filed on April 4, 2005 under 37 CFR 1.131 has been considered but is ineffective to overcome the Tanner et al. reference (U.S. 2003/0119043 A1). The Tanner et al. reference is a U.S. patent or U.S. patent application publication of a pending or patented application that claims the rejected invention. An affidavit or declaration is inappropriate under 37 CFR 1.131(a) when the reference is claiming the same patentable invention, as defined in 37 CFR 1.601(n), see MPEP § 2306. 37 CFR 1.601(n) states Invention "A" is the same patentable invention as an invention "B" when invention "A" is the same as (35 U.S.C. 102) or is obvious (35 U.S.C. 103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A". It is obvious to the person having ordinary skill in the art that the polynucleotide in claim 17, and 18 of the Tanner et al. reference encodes the polypeptide having 100 % identity with the currently claimed SEQ ID NO: 4 polypeptide. If the reference and this application are not commonly owned, the reference can only be overcome by establishing priority of invention through interference proceedings. See MPEP Chapter 2300 for information on initiating

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interference proceedings. If the reference and this application are commonly owned, the reference may be disqualified as prior art by an affidavit or declaration under 37 CFR 1.130. See MPEP § 718.

#### Art of Record

The teachings of Ota, T. et al. and Brett, D. et al. are effectively the same as Tanner et al. and could be used to reject the claims under 102(b) and 102(a), respectively, but to do so would be cumulative.

8. Ota, T. et al. (EP 1074617 A2, Publication date = February 7, 2001). Ota, T. et al. disclose a substantially pure protein that has 100 % identity to the currently claimed polypeptide identified as SEQ ID NO: 4. A disclosed structural polypeptide will inherently dictate a function upon the disclosed polypeptide. Therefore, the peptide that has 100% identity would be expected to possess the function currently being claimed (see EP 1074617 A2, SEQ ID NO: 16726, and claims 2, 3, 4, and 6).

9. Brett, D. et al. (DE 10126472 A1, Publication date = August 1, 2002). Brett, D. et al. disclose a substantially pure protein that has 100 % identity to the currently claimed polypeptide identified as SEQ ID NO: 4. A disclosed structural polypeptide will inherently dictate a function upon the disclosed polypeptide. Therefore, the peptide that has 100% identity would be expected to possess the function currently being claimed (see DE 10126472 A1, attached sequence alignment).

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**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anand U. Desai, Ph.D. whose telephone number is (571) 272-0947. The examiner can normally be reached on Monday - Friday 7:00 a.m. - 3:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon P. Weber can be reached on (517) 272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 7, 2005



**KAREN COCHRANE CARLSON, PH.D.**  
**PRIMARY EXAMINER**